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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,485	08/27/2001	Chikako Kariya	1484.1007	2872
21171	7590	08/13/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			PAULA, CESAR B	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/938,485

Applicant(s)

KARIYA, CHIKAKO

Examiner

CESAR B PAULA

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1/16/02.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 2178

### **DETAILED ACTION**

1. This action is responsive to the application, and IDS filed on 8/27/2001, and 1/16/2002 respectively.

**This action is made Non-Final.**

2. Claims 1-57 are pending in the case. Claims 1, 11, 20, 30, 39, and 49, are independent claims.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 1/16/2002 has been entered, and considered by the examiner.

### ***Priority***

4. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), and based on application # 200-373784 filed in Japan on 12/8/2000, which papers have been placed of record in the file.

### ***Drawings***

5. The drawings filed on 8/27/2001 have been approved by the examiner.

Art Unit: 2178

***Claim Objections***

6. Claims 1-10 are objected to because of the following informalities: “a locater” in claim 1, line 3. This is better written as “a locator”. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 43-44, and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 43-44, and 46 recite the limitation “The displaying step” in claim 43, lines 1-2. There is insufficient antecedent basis for this limitation in the claim. There is no previous “displaying step” in this claim, **which depends on itself**. This limitation seems to point to claim 42, and therefore is rejected accordingly below.

10. Claim 16, 35, and 54 recite the limitations “merges documents from a document selected”, “merges documents from a document selected”, and “merging documents from a document selected” in lines 2, 2-3, and 2 respectively. It is unclear how several documents are merged from a single document. This seems to be an impossibility, because how can one merge many documents, if there is only one source document to merge from.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-57 are rejected under 35 U.S.C. 102(b) as being anticipated by Moody et al, hereinafter Moody (Pat.# 5,890,177, 3/30/1999).

Regarding independent claim 1, Moody discloses comparing an original document and an edited copy of the same document to determine similarities, and differences, if any, among the documents (col.7, lines 21-67).

Furthermore, Moody discloses the comparison of similarities and differences—*relevance information*-- between paragraphs of two documents, such as an original document, and an edited copy of the original document (which was edited after the original document was created—*timewise latest document*--based on a heritage —*header*-- containing a timestamp—*timewise order*-- indicating when the document was created or edited) (col.10, lines 15-35).

Regarding claim 2, which depends on claim 1, Moody discloses the comparison of similarities or differences between paragraphs of two documents, based on a creator ID —*header information* (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 3, which depends on claim 2, Moody discloses presenting or displaying the documents and their similarities and differences—*relevance information*-- in a visible way using techniques such as redlining, in a marked up document in a tree-like order with the original document on top followed by the edited copies—*outputs the relevance information in a timewise order*-- (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 4, which depends on claim 1, Moody discloses presenting or displaying the documents and their similarities and differences in a visible way using techniques such as redlining, in a marked up document in a tree-like order with the original document on top followed by the edited copies (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 5, which depends on claim 4, Moody discloses presenting or displaying the documents and their similarities and differences in a visible way using techniques such as redlining, in a marked up document in a tree-like order with the original document on top followed by the edited copies (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 6, which depends on claim 5, Moody discloses presenting or displaying the documents—*document selected at the locator*-- and their similarities and differences in a visible way using techniques such as redlining, in a marked up document in a tree-like order with the original document on top followed by the edited copies (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Art Unit: 2178

Regarding claim 7, which depends on claim 2, Moody discloses the comparison of differences—*branched state--* between paragraphs of two documents, based on a creator ID — *header information according to a uniqueness rule in each of the documents*. The differences or edits—*detected branched state--* are presented in a visible way using techniques such as redlining (col. 6, lines 1-67, col.10, lines 15-35).

Regarding claim 8, which depends on claim 5, Moody discloses the comparison of differences—*branched state--* between paragraphs of two documents, based on a creator ID — *header information according to a uniqueness rule in each of the documents*. The differences or edits—*detected branched state--* are presented in a visible way using techniques such as redlining , in a marked up document in a tree-like order with the original document on top followed by the edited copies (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 9, which depends on claim 1, Moody discloses returning edited copies of the original document back to the author using email—*the documents are email documents*. The documents are arranged in a hierarchical tree-like order in a markup document (col. 6, lines 1-67, col.10, lines 15-35, fig.3). In other words, the original document is presented along with the emailed copies of the edited original document, so that the documents in the markup document represents a history of the emailed documents' editions by the various authors.



Art Unit: 2178

Regarding claim 10, which depends on claim 9, discloses returning edited copies of the original document back to the author using email—*the documents located by the locator are subjected to a return mail processing*. The documents are arranged in a hierarchical tree-like order in a markup document (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding independent claim 11, Moody discloses comparing an original document and an edited copy of the same document to determine differences, if any, among the documents (col.7, lines 21-67).

Moreover, Moody discloses a word processing software for deleting duplicate paragraphs of the documents, and producing a final document (col.7, lines 1-20). In other words, the software is used to go through all the paragraphs and removes the duplicate paragraphs, and creates a final document without the duplicate paragraphs—*parsing overlapped portion of information and for merging the documents with the overlapped portion eliminated*.

Regarding claim 12, which depends on claim 11, Moody discloses the merging of the final document by using a document containing various editions of the original document organized in an order that presents the original paragraphs first, followed by other edited paragraphs—*merges the documents according to an order of the related documents* (col.6, lines 56-67, fig.3).

Regarding claim 13, which depends on claim 11, Moody discloses the comparison of paragraphs based on an on heritage containing an ID of the editor who made the edits to the

Art Unit: 2178

corresponding document—*detect relevance among the documents based on the header information* or editor initials (col.10, lines 15-35).

Regarding claim 14, which depends on claim 13, Moody discloses the comparison of paragraphs of two documents, based on a heritage —*header--* containing a timestamp—*timewise order--* indicating when the document was created or edited—*detect relevance among the documents based on the header information* or editor initials. The differences or edits are presented in a visible way using techniques such as redlining, in a marked up document in a tree-like order with the original document on top followed by the edited copies—*timewise order* (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 15, which depends on claim 11, Moody discloses the display of a markup document containing various editions—*relevance documents--* of the original document organized in a tree order that presents the original paragraphs first, followed by other edited paragraphs (col.6, lines 56-67, fig.3).

Regarding claim 16, which depends on claim 15, Moody discloses using the markup document containing various editions, and which is displayed in a tree order, for producing, and displaying a final document creating by merging several of the edited documents—*relevance documents--* of the original document organized in an order that presents the original paragraphs first, followed by other edited paragraphs (col.6, lines 56-col.7, line 20, fig.3).

Art Unit: 2178

Regarding claim 17, which depends on claim 13, Moody discloses the comparison of differences—*branched state--* between paragraphs of two documents, based on a creator ID — *header information according to a uniqueness rule in each of the documents*. The differences or edits—*detected branched state--* are presented in a visible way using techniques such as redlining (col. 6, lines 1-67, col.10, lines 15-35).

Regarding claim 18, which depends on claim 15, Moody discloses the comparison of differences—*branched state--* between paragraphs of two documents, based on a creator ID — *header information according to a uniqueness rule in each of the documents*. The differences or edits—*detected branched state--* are presented in a visible way using techniques such as redlining, in a marked up document in a tree-like order with the original document on top followed by the edited copies (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Claim 19 is directed towards a device equivalent to the device found in claim 9, and therefore is similarly rejected.

Claims 20-38 are directed towards a computer program product on a computer-readable medium for performing the steps found in claims 1-18, and 9 respectively, and therefore are similarly rejected.

Claims 39-57 are directed towards a method for implementing the device found in claims 1-18, and 9 respectively, and therefore are similarly rejected.

Art Unit: 2178

***Conclusion***

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nolan (Pat. # 5,933,599), Sanu et al. (Pat. # 5,974,409), Freivald et al. (Pat. # 6,219,818), Dehita et al. (Pat. # 6,411,924), Sites (Pat. # 6,324,555), and DeStefano (Pat. # 6,308,187).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is **(703) 306-5543**. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (703) 308-5465. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Or faxed to:

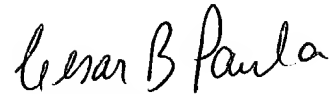
- **(703) 703-872-9306**, (for **all** Formal communications intended for entry)

Application/Control Number: 09/938,485

Page 11

Art Unit: 2178

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA, Sixth Floor (Receptionist).**



CESAR B PAULA

Patent Examiner

Art Unit 2178

8/5/04